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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,275	04/09/2004	Woon Kok Tan	50103-545	9387
41552 7590 10/15/2008 MCDERMOTT, WILL & EMERY 4370 LA JOLLA VILLAGE DRIVE, SUITE 700 SAN DIEGO, CA 92122				
EXAMINER				
MISLASZEK, MICHAEL				
ART UNIT		PAPER NUMBER		
3625				
MAIL DATE		DELIVERY MODE		
10/15/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/821,275

Applicant(s)

TAN ET AL.

Examiner

Michael Misiaszek

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Prosecution Status

Applicant's remarks filed 7/9/2008 have been received and reviewed. The status of the claims is as follows:

Claims 1-23 are pending.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-15, 17-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Waddington.

Regarding Claims 1-4

Waddington discloses a method of creating invoices for goods or services supplied to a buyer from a supplier, comprising:

- receiving the goods or services at the buyer, the receipt of the goods or services evidenced by a receipt document (at least paragraph [0011]: item delivery and receipt record)

- the buyer generating invoices based on the receipt document and providing the generated invoices to the supplier (at least paragraph [0011]: buyer verifies contents using shipping record and item lists)
- wherein the receipt document reflects actual goods or services received by the buyer (at least paragraph [0011]: receipt record includes shipping unit and discrepancies)
- wherein the buyer pulls the goods or services from the supplier (at least paragraph [0010]: customer obtains items from retail store through distribution center)
- wherein a third party logistics warehouse system is interposed between the supplier and the buyer, such that the third party logistics warehouse system receives the goods or services from the supplier and makes the goods or services available to the buyer (at least paragraph [0010]: distribution center)

Regarding Claims 5-9

Waddington further discloses:

- wherein the buyer pulls the goods or services from the third party logistics warehouse system (at least paragraph [0010]: customer obtains items from retail store through distribution center)
- checking the generated invoices and determining whether the generated invoices are approved prior to providing the generated invoices to the supplier (at least paragraph [0011]: obtaining customer signature)
- the buyer generating reports based on the generated invoices, the reports containing logistical data (at least paragraph [0011]: creating list of discrepancies)
- a plurality of suppliers that supply the goods or services to the buyer, the plurality of suppliers being identifiable by the buyer such that a particular supplier supplying particular goods or services is identified by the buyer upon receipt of the goods or services (at least figures 1 and 3: plurality of retail stores and retail store identifier on shipping label)
- determining whether goods are returned to the supplier, and generating a debit memo if goods have been returned to the supplier (at least paragraph [0010]: returns record)

Regarding Claims 10-15

Waddington discloses a computer readable media bearing instructions that cause a computer at a buyer to:

- determine at the buyer that goods have actually been received at the buyer (at least paragraph [0011]: electronically verifying delivery contents)
- create an invoice at the buyer based on the determination that goods have actually been received at the buyer (at least paragraph [0011]: electronically creating receipt and shipping records)
- wherein the instructions further cause the computer to generate an invoice report and forward the invoice report to a vendor (at least paragraph [0123]: records sent to retailer)
- wherein the determination at the buyer that goods have actually been received includes inputting a receipt traveler upon verification of goods received at the buyer (at least paragraph [0011]: receipt record and signature confirmation from buyer)
- wherein the instructions further cause the computer to create a purchase order for goods (at least paragraph [0077]: order for items generated)
- wherein the instructions further cause the computer to forward the invoice to an invoice approval process prior to generating an invoice report (at least paragraph [0011]: customer signature)

- wherein the instructions further cause the computer to generate a debit memo when goods are returned to a vendor (at least paragraph [0010]: return records created)

Regarding Claims 17-20

Waddington discloses an invoicing system for goods and services, comprising:

- a computer system (at least figure 4)
- means for creating invoices from the computer system at a buyer based on goods or services actually received at the buyer (at least paragraph [0011]: electronically creating receipt and shipping records)
- wherein the means for creating invoices includes means for creating the invoices based on receipt documents that document the actual receipt of the goods or services at the buyer (at least paragraph [0011]: electronically creating receipt and shipping records)
- means for providing an invoice report to a vendor based on the invoices created at the buyer (at least paragraph [0123]: delivery reports sent to retailer)
- means for generating a debit memo to the vendor when goods are returned to the vendor (at least paragraph [0010]: receipt reports generated)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Waddington in view of Shore.

Waddington discloses the claimed invention except for:

- the instructions further cause the computer to forward the invoice report to the vendor by electronic mail.

Shore teaches that it is known to include forwarding an invoice by electronic mail (at least paragraph [0199]) in a similar environment. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the invoicing method and system, as taught by Waddington, with the invoice forwarding by electronic mail, as taught by Shore, since such a modification would have provided a mobile, user-friendly purchasing means for electronic transactions (at least paragraph [0004] of Shore).

3. Claims 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Waddington.

Waddington substantially discloses the claimed invention, as detailed with claims 1 and 17 above. Waddington does not explicitly disclose that the invoices created by the buyer include both quantity and prices of supplied goods or services. However, applicant's own specification (see paragraph [04]) acknowledges that an invoice including both quantities and prices of goods or services is common practice. Such disclosure is considered by the Examiner to be an admission of prior art. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to have modified the system and method, as taught by Waddington, to have included both quantity and price on a buyer created invoice.

Response to Arguments

Applicant's arguments with respect to claims 1-23 have been fully considered, but they are not persuasive. Applicant asserts that Waddington does not disclose buyer-created invoices. Applicant's assertion is based on the fact that applicant considers an "invoice" to include both quantities and prices of items, and Waddington's lack of disclosure of such prices. As noted in previous actions, the Examiner considers an "invoice" to be, in its broadest reasonable interpretation, a list of goods shipped or services rendered. This interpretation is, in fact, supported by the unabbreviated version of the dictionary definition provided by the applicant: "1: an itemized list of goods shipped [***usually***] specifying the price and the terms of sale: BILL" (emphasis added). While it is possible, and even common, for invoices to specify the price of goods, it is not, according to the accepted definition provided by the applicant and reproduced above by the Examiner, required for an invoice to include pricing information. That is, a list of goods shipped, as disclosed in Waddington, falls within the scope of the definition provided. Accordingly, the Examiner respectfully asserts that the interpretation previously applied to the term "invoice" by the Examiner (and maintained in the present rejection) is valid. Therefore, Waddington discloses the claimed invention, as detailed in the rejection above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Misiaszek whose telephone number is (571)272-6961. The examiner can normally be reached on 9:00 AM - 5:30 PM, Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on (571) 272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey A. Smith/
Supervisory Patent Examiner, Art
Unit 3625

Michael A. Misiaszek
Patent Examiner
10/10/2008